

REMARKS

Claims 1-44 are pending in the present application. The Examiner has restricted the claims into three groups as follows:

1. Group I, claims 1-38, drawn to a process of making the compound;
2. Group II, claims 39-41, drawn to the compound itself; and
3. Group III, claims 42-44 drawn to use of the compound.

The Examiner requires Applicants to elect one of the three groups for further prosecution. The Examiner alleges that the compound is known.

As a preliminary matter, Applicants amend the claims to conform more closely to accepted United States claim format. Markush language has been inserted where appropriate in claims 1, 7, 25 and 36. "Characterized in that" has been changed to "wherein" in each occurrence. Further, claim 1 has been written in proper United States "method" format so that each step is numbered and begins with an "action" word ending in -ing as required. Further, claim 1 is described as a method rather than a process as preferred. Likewise, all dependent claims refer to "The method" thereby providing proper antecedent basis. Claim 39 is written in standard "product by process" format. No issue of new matter arises by way of these changes since they are purely formal in nature. Further, Applicants correct an obvious error in claim 1, third step where the freezing temperatures are now properly indicated at negative Celsius degrees as one of ordinary skill in the art would realize this was intended.

Regarding the Restriction Requirement

Applicant hereby responds by electing Group I with traverse. Applicant respectfully requests reconsideration of the Requirement for Restriction to allow prosecution of more than one group of claims. Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are "'independent'" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP

802.01). The term "distinct" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicant respectfully submits that the groups designated by the Examiner fail to define compositions and methods so distinct as to warrant separate Examination and Search. The Examiner's assertions to the contrary notwithstanding, Applicant respectfully submits that conjoint examination and inclusion of all of the claims of the present Application would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction, is in order.

Regarding the Election of Species Requirement

If Group I is elected in response to the Restriction Requirement, the Examiner also requires electing one species from the following for prosecution:

1. Claim 1, step 3, "means to deactivate the β -D-galactosidase: freezing, heating or filtering;
2. Claim 1, step 5, "solvent mixtures of acetone/methanol or acetone water;
3. Claim 7, "type of filtration column"
4. Claim 36, "type of β -D-galactopiranoside substrate: O-nitrophenyl- β -D-galactopiranoside or lactose"; and

5. Claims 37 and 38, “type of β -D-galactosidase source: *E. coli* or *Kluyveromyces lactis*.

That is, in each of the above instances, Applicant must choose one from each of the 5 groups for initial examination. The Examiner acknowledges the obligation to search the other species if Applicants introduce a generic claim into the claims by way of amendment. Applicants herein amend the claims to provide a generic claim by changing the claim format to incorporate more standard United States patent Markush group language. Applicants remind the Examiner of the obligations for examining Markush claims as set forth in M.P.E.P. 803.02.

Applicants herein elect the following species for examination respectively:

1. Heating;
2. Mixtures of acetone/water;
3. Active carbon filtration column type;
4. O-nitrophenyl- β -D-galactopyranoside; and
5. *E. coli*

Applicants further respectfully remind the Examiner of the requirements of 37 C.F.R. §1.141 providing that Applicants are entitled to consideration of claims to additional species written in dependent form upon allowance of a generic claim.

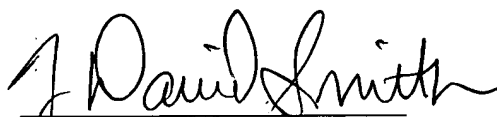
Applicants submit that “heating” is readable on claims 1-32 and 34-38. “Mixtures of acetone/water” is readable on claims 1-2 and 4-38. “Active carbon filtration column type” is recited in claim 7, and is readable on claims 7-10 and 14. “O-nitrophenyl- β -D-galactopyranoside” is expressly recited in claim 36, and is readable on claim 36. Applicants further maintain that the Examiner is incorrect in issuing an Election of Species requirement as regards claims 37 and 38. Neither claim is generic. Rather, both claims are dependent and each recite only one species each. As such, both species are readable upon claim 1, and each is

readable upon its respective claim 37 or 38. E. coli is readable on claim 37, and Kluyveramyces lactis is readable on claim 38.

CONCLUSION

Entry of the foregoing remarks into the record of the above identified application is respectfully requested. It is believed that all of the claims are in condition for allowance. If any issue can be resolved telephonically, the Examiner is requested to call the undersigned at the phone number provided.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. David Smith". The signature is written in a cursive, flowing style.

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